

REMARKS/ARGUMENTS

Re-examination and favorable reconsideration in light of the above amendments and the following comments are respectfully requested.

Claims 1 - 11 and 24 - 26 are pending in the application. Currently, no claim stands allowed.

By the present amendment, claims 1 and 4 have been amended to delete the word "comprising" in favor of the phrase "consisting of".

In the office action mailed December 28, 2004, claims 1 - 5 were rejected under 35 U.S.C. 112, first paragraph; claims 1, 2, and 5 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,366,695 to Erickson in view of U.S. Patent No. 4,302,256 to Kenton; and claims 3, 4, 6 - 11 and 24 - 26 were rejected under 35 U.S.C. 103(a) as being unpatentable over Erickson in view of Kenton and further in view of U.S. Patent No. 5,605,584 to DeLuca et al.

The foregoing rejections are traversed by the instant response.

The present invention relates to a nickel base superalloy having a composition of from 3.0 to 12 wt% chromium, up to 3.0 wt% molybdenum, 3.0 to 10 wt% tungsten, less than 5.0 wt% rhenium, 6.0 to 12 wt% tantalum, 4.0 to 7.0 wt% aluminum, up to 15 wt% cobalt, up to 0.05 wt% carbon, up to 0.02 wt% boron, up to 0.1 wt% zirconium, up to 0.8 wt% hafnium, up to 2.0 wt% niobium, up to 1.0 wt% vanadium, up to 0.7 wt% titanium, up to 10 wt% of at least one element selected from the group consisting of ruthenium, rhodium, palladium, osmium, iridium, platinum, and mixtures thereof, and the balance essentially nickel. The nickel base superalloy also has a microstructure which is pore free and eutectic γ - γ' free.

The rejection under 35 U.S.C. 112, first paragraph is without merit and should be withdrawn. The original disclosure called for up to 5.0 wt% rhenium. In other words, the original specification discloses that the alloy could have rhenium in amount from 0% to 5.0 wt% rhenium. It is submitted that the originally disclosed range set forth in the written description includes an amount of rhenium less than 5.0 wt%. Thus, the objected to claim language is fully supported by the original written description in the originally filed specification. The fact that the exact claim language can not be found in the specification is not relevant to the inquiry as to whether a claim limitation is supported in the original specification. Nor does it matter that there has been a change in claim scope. Most amendments narrow the scope of the claim. For these reasons, the Examiner is hereby requested to withdraw the rejection under 35 U.S.C. 112, first paragraph.

Claim 1 (as amended herein), and claims 2 and 5 are clearly allowable over the combination of the Erickson and Kenton patents. As noted in the Examiner's comments, Erickson teaches an alloy composition which includes from about 5.0 to 7.0 wt% rhenium (see Abstract and claims 1 and 16) or about 5.5 to 6.5 wt% rhenium (see claims 12 and 28). Nowhere does Erickson teach or suggest a composition having less than 5.0 wt% rhenium. Thus, Erickson does not teach or suggest the composition set forth in claims 1 and 4. The Kenton patent relied upon by the Examiner does not cure the compositional deficiency of Erickson. Thus, for this reason alone, claims 1 and 4 are allowable over the proposed combination of references.

With regard to the Examiner's comments in paragraph 6a of the office action on page 6, the analysis by the Examiner is

incorrect. Erickson never says what is meant by the word "about". Thus, one can not properly rely on vague language in a reference as an affirmative teaching of a claim limitation. It is submitted that the interpretation being applied by the Examiner is the Examiner's interpretation of Erickson's claim language. It is improper to apply such an interpretation to reject a claim.

The rejection is further defective in that Erickson does not teach one of ordinary skill in the art how to make and use an alloy of the above composition that is pore free. The Examiner attempts to overcome this deficiency by applying the Kenton patent. However, Kenton does not teach one how to form an alloy with the claimed composition that is pore free. As noted by the Examiner, Kenton teaches a HIP method which improves mechanical properties of alloys including the "substantially complete removal of defects such as micropores." Applicants submit that this is not a teaching of how to make an alloy which has a pore-free microstructure. The fact that Kenton uses the terminology "substantially complete removal" instead of "complete removal" shows that alloys processed by the Kenton process do not have a pore-free microstructure.

In fact, neither Kenton nor Erickson express any desire to have a microstructure which is pore free. Since Kenton does not accomplish a pore-free microstructure, there is nothing which would motivate one of ordinary skill in the art to combine it with Erickson in the manner suggested by the Examiner. The motivation statement by the Examiner is wrong in that while Kenton may remove casting defects such as pores, it does not remove them in their entirety - hence, no pore-free microstructure.

Further, neither of the cited and applied references teaches or suggests how to form an alloy which is eutectic γ - γ' free. The Examiner's reliance on the desire of Erickson to fully solutionize the gamma prime phase as inherently meaning that the alloy is eutectic γ - γ' free is misplaced. In order to dissolve the eutectic γ' phase, special heat treatments are required. Neither Erickson nor Kenton disclose such heat treatments. It should be recognized by the Examiner that there is a cooling γ' phase which can be solutionized and later precipitated out. Since Erickson does not disclose a set of heat treatments for solutionizing out the eutectic γ' phase, it can not be said that it follows that the solutionizing performed by Erickson creates a microstructure which is eutectic γ - γ' free. For all anyone knows, Erickson is dealing with the cooling γ' phase. Thus, the Examiner's inherency argument fails. If the Examiner is going to rely on this inherency argument, then the Examiner must point out exactly where Erickson discloses the heat treatments capable of dissolving the eutectic γ' phase.

For these reasons, claim 1 is allowable over the proposed combination of references.

Regarding claims 2 and 5, these claims are allowable for the same reasons as claim 1, as well as the fact that none of the cited and applied references teaches or suggests a microstructure which is pore free, eutectic γ - γ' free, bimodal and/or single crystal.

The rejection of claims 3, 4, 6 - 11, and 24 - 26 over the combination of Erickson in view of Kenton in view of DeLuca et al. fails because DeLuca et al. does not cure the above-noted deficiencies of Erickson and Kenton. Still further, DeLuca relates to the treatment of alloys which do not contain rhenium

and also relates to the formation of a trimodal γ' distribution. It is submitted that claims 4, 6, 10, and 24 are allowable because none of the references teach or suggest how to form an object or an alloy having a microstructure which is pore free, eutectic γ - γ' free, and a gamma prime morphology which is bi-modal. It is further submitted that none of the cited and applied references teach or suggest forming large γ' particles which are octet shaped in combination with fine γ' particles which are cuboidal in shape. On this point, it should be noted that lines 44 and 45 in column 3 of the DeLuca patent does not mean that the particles are octet shaped. An octet shape has eight sides. A particle with four branches could have more than eight sides. A four branch particle could have twelve sides.

The remaining claims are allowable for the same reasons as their parent claims as well as on their own accord.

With regard to the Examiner's comments in paragraph 6b, the inherency argument relied upon by the Examiner fails for the reasons discussed above as well as the Examiner's observation that the method of product taught by Erickson in view of Kenton and DeLuca et al. is only substantially identical to the method disclosed in the specification. It is those differences between the methods which would lead one to conclude that the products formed by the present invention would have different properties than the products formed by the cited and applied references. It can not be said that the same resistance to initiation and propagation of fatigue cracks as claimed would inherently flow from an admitted different method. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. See *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed.

Cir. 1991). The Examiner has provided no explanation as to why the claimed properties must inherently flow from the references.

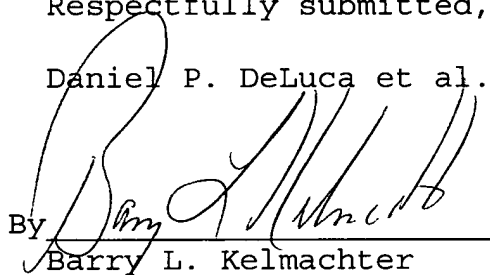
For the foregoing reasons, the instant application is believed to be in condition for allowance. Such allowance is respectfully solicited.

Should the Examiner believe an additional amendment is needed to place the case in condition for allowance, he is hereby invited to contact Applicants' attorney at the telephone number listed below.

No fee is believed to be due as a result of this response. Should the Commissioner determine that a fee is due, he is hereby authorized to charge said fee to Deposit Account No. 21-0279.

Respectfully submitted,

Daniel P. DeLuca et al.

By 
Barry L. Kelmachter
BACHMAN & LaPOINTE, P.C.
Reg. No. 29,999
Attorney for Applicants

Telephone: (203) 777-6628 ext. 112

Telefax: (203) 865-0297

Email: docket@bachlap.com

Date: February 28, 2005

I, Nicole Motzer, hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313" on February 28, 2005.

